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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,276	06/29/2001	Y. Tom Tang	PF-0609 USN	6626

7590

05/23/2003

Incyte Genomics Inc
Legal Department
3160 Porter Drive
Palo Alto, CA 94304

EXAMINER

ROBINSON, HOPE A

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,276

Applicant(s)

TANG ET AL.

Examiner

Hope A. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Restriction/Election

1. Restriction is required under 35 U.S.C. 121 and 372.

5 This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

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Group I. Claims 1-2, 15 and 19 are drawn to a purified polypeptide and fragments thereof of SEQ ID NO: 1 or 2 (i.e. the protein can be used as a receptor, to produce antibodies, or in assays to identify agonists or antagonists).

15 Group II. Claims 3-6 and 9-14 are drawn to an isolated and purified polynucleotide of SEQ ID NO: 3 or 4.

Group III. Claims 7-8 are drawn to a method for detecting a polynucleotide.

Group IV. Claim 16 is drawn to a purified antibody.

Group V. Claim 17 is drawn to a purified agonist (i.e. antibody agonist).

20 Group VI. Claim 18 is drawn to a purified antagonist (i.e. monoclonal antibody antagonist).

Group VII. Claim 20 is drawn to a method of treating or preventing a disorder using the antagonist.

25 2. The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following

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reasons: because the products of Groups I, II, IV, V and VI are physically and structurally different, having different modes of operation. For example, although the protein of Group I and the agonist of Group V have similar activities, they have different structures. With regard to the antagonist of Group VI and the protein of Group I, the two products differ in structure and have opposing function. The antibody of Group VI is related to the protein of Group I, however, the protein can be used in different processes, for example to produce the antibody. The DNA of Group II and the protein of Group I are related because the DNA encodes the protein, however, they are distinct as the protein can be made by a different process and the two products have different functions, for example the DNA can be used in a hybridization assay. Additionally, the invention of Group I does not escape the prior art as Shuford et al. teach the claimed protein (WO 91/06305, May 16, 1991), thus the inventions of Groups I-VII are not linked by a special technical feature.

The methods of Groups III and VII are different having different end points and uses different products. Thus, these inventions are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

3. A telephone call was made to Mr. Richard Ekstrom on May 14, 2003 to request an oral election to the above requirement, but did not result in an election being made because the attorney had to contact the applicant.

Applicant is advised that the response to this election requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-

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5 elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor-ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hope A. Robinson whose telephone number is (703)308-6231. The Examiner can normally be reached on Monday - Friday from 9:00 A.M. to 6:30 P.M. (EST).

10 If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Christopher S.F. Low, can be reached at (703)308-2923.

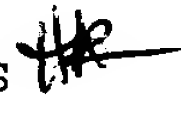
Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703)308-0196.

15 Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-2742. Please affix the Examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

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CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Hope A. Robinson, MS 
Patent Examiner